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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Mannington Mills, Inc.

Serial No. 76/199,575

Sherry H. Flax of Saul Ewing LLP for Mannington Mills, Inc.

Marc J. Leipzig, Trademark Examining Attorney, Law Office
115 (Tomas V. Vlcek, Managing Attorney).

Before Seeherman, Hanak and Drost, Administrative Trademark
Judges.

Opinion by Drost, Administrative Trademark Judge:

On January 26, 2001, Mannington Mills, Inc.
(applicant) applied to register the mark SCRATCHRESIST in
typed form on the Principal Register for goods ultimately
identified as "hardwood flooring which contains a coating
in the nature of a wood floor finish" in International
Class 19.

The application (Serial No. 76/199,575) was based on an allegation of a bona fide intention to use the mark in commerce.¹

The examining attorney refused registration on the ground that the mark was merely descriptive under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), because the mark SCRATCHRESIST describes a feature of the goods. "A floor which resists scratches, or a floor finish which resists scratches is an important feature of such goods." Brief at 4. The examining attorney goes on to argue that "applicant's mark, SCRATCHRESIST, is essentially the equivalent of the phrase 'scratch-resistant,' a phrase routinely used to describe hardwood floors and various finishes and coatings for hardwood floors. Far from creating an incongruous combination of words, applicant's mark merely combines two descriptive terms into an equally descriptive composite mark." Id.

On the other hand, applicant maintains that its mark creates a unique commercial impression and that "the existence of other common meanings of the term 'scratch' mandates the conclusion that the mark is not merely

¹ On March 30, 2001, applicant filed an Amendment to Allege Use that contained a specimen and an allegation of a date of first use and first use in commerce of December 2000.

descriptive." Brief at 3. Applicant also argues that the registration of other marks that contain the term "scratch" justify the registration of its mark SCRATCHRESIST.

After the examining attorney made the refusal final, applicant appealed to this Board.

We affirm.

For a mark to be merely descriptive, it must immediately convey knowledge of the ingredients, qualities, or characteristics of the goods or services. In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009, 1009 (Fed. Cir. 1987); In re Quik-Print Copy Shops, Inc., 616 F.2d 523, 205 USPQ 505, 507 (CCPA 1980). Courts have long held that to be "merely descriptive," a term need only describe a single significant quality or property of the goods. Gyulay, 3 USPQ2d at 1009; Meehanite Metal Corp. v. International Nickel Co., 262 F.2d 806, 120 USPQ 293, 294 (CCPA 1959). Descriptiveness of a mark is not considered in the abstract, but in relation to the particular goods or services for which registration is sought. In re Abcor Dev. Corp., 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978).

The examining attorney introduced numerous printouts to show that the term SCRATCHRESIST would be perceived by potential purchasers as a term that describes a feature or quality of the goods. The following examples show that

terms such as "resist scratches" and "scratch resistant" are commonly used to describe products that keep wood and floors from scratching.

One reason wood flooring is having a rebirth is the urethane finish most homeowners choose. Throughout the '90s, the coatings have become more durable, able to resist spilled water, some scratches and general wear.

Columbus Dispatch, February 19, 2000.

Varnish is ideal for finishing floors, counters, cabinets and wood furniture because it resists scratches and stains better than wax or oils.

Washington Post, October 2, 1997.

Hardwood floors can be either solid or veneer... Scratch-resistant and stain resistant polyurethane finishes applied over the stain cut down on the necessity for refinishing.

Plain Dealer, August 2, 1997.

The tough, aluminum oxide finish recommended for high-traffic areas resists scratches but isn't immune to scratches, punctures or dents. "Some companies overstate their product's durability," said Wayne Wenger, Home Valu floor buying expert. "Just like wood, it can scratch. You need to protect it like any wood floor."

They sell and install carpet, linoleum, ceramic tile and laminates - wood slates with a hard surface that resists dents and scratches.

Daily Town Talk (Alexandria, LA), May 18, 1999.

A real wood floor can last indefinitely, although it needs refinishing from time to time.

Although laminates are scratch-resistant, they are not impervious to scratching and scarring.

Washington Post, January 8, 2000.

The printouts indicate that, when the terms "scratch" and "resist" and their equivalents are used in relation to

wood flooring, they mean the product "resists scratches." As the articles above demonstrate, scratch-resistance is an important feature for wood flooring.

Likewise, applicant's specimens indicate that the applicant's term would inform prospective purchasers that the term means scratch-resistant: "On selected patterns, our urethane wearlayer is enhanced with aluminum oxide to create a ScratchResist finish. ScratchResist helps your floor to look new longer by *resisting* everyday household scratches" (emphasis added).

We also do not find that there is anything in the way applicant has combined the terms "scratch" and "resist" that would take away from the descriptive meaning the combined term would have when it is applied to hardwood flooring. See In re Gould Paper Corp., 834 F.2d 1017, 5 USPQ2d 1017 (Fed. Cir. 1987) (SCREENWIPE generic for a wipe for cleaning television and computer screens); Abcor Dev. (GASBADGE at least descriptive for gas monitoring badges; three judges concurred in finding that term was the name of the goods); In re Orleans Wines, Ltd., 196 USPQ 516 (TTAB 1977) (BREADSPRED descriptive for jams and jellies that would be a spread for bread); In re Perkin-Elmer Corp., 174 USPQ 57 (TTAB 1972) (LASERGAGE merely descriptive for interferometers utilizing lasers). There is nothing

incongruous about the term 'Scratchresist" for scratch-resistant wood flooring.

While applicant argues that consumers are likely "to interpret the mark SCRATCHRESIST as a manual for golfers, a preparation to stop itching, or a cake mix" (Brief at 3), it is clear that applicant has not applied the correct test. The test is not whether prospective purchasers can guess what applicant's goods are after seeing applicant's mark alone. Abcor Dev., 200 USPQ at 218 ("Appellant's abstract test is deficient - not only in denying consideration of evidence of the advertising materials directed to its goods, but in failing to require consideration of its mark 'when applied to the goods' as required by statute"). We must look at the mark in the context of applicant's goods to see if the mark informs prospective purchasers of a feature or characteristic of applicant's goods. In this context, applicant's mark clearly informs potential purchasers of a significant feature of applicant's goods in that applicant's hardwood floors are designed to resist scratches.

Finally, applicant argues that there are "dozens of marks that use the term SCRATCH in connection with preparations that are used to eliminate scratches or goods that have a protective coating." Brief at 3. Applicant

has in fact attached copies of 13 registrations.² The list consists of 5 cancelled registrations,³ two registrations (one expired) under Section 2(f), and one registration on the Supplemental Register. Many have disclaimed the word "scratch." No registration contains the word "resist" or a variation of it. There is no rule that prevents the registration of marks containing the word "scratch" when it is combined with a non-descriptive term, so the fact that there are or were 13 registrations that contain the word "scratch" is hardly significant. Indeed, every case must be determined on its own record. Nothing about the registrations that applicant has submitted indicates that its mark is not descriptive of its goods. We note that even "if some prior registrations had some characteristics similar to Nett Designs' application, the PTO's allowance of such prior registrations does not bind the Board or this court." In re Nett Designs Inc., 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001).

² We have not considered the registrations applicant refers to for the first time in its reply brief. Even if applicant submitted copies of these registrations, which it did not, it is too late to submit additional evidence. In re Duofold, Inc., 184 USPQ 638, 640 (TTAB 1974) ("[T]he submission of a list of registrations is insufficient to make them of record"); 37 CFR § 2.142(d) ("The record in the application should be complete prior to the filing of an appeal").

³ "[A] canceled registration does not provide constructive notice of anything." Action Temporary Services Inc. v. Labor Force Inc., 870 F.2d 1563, 10 USPQ2d 1307, 1309 (Fed. Cir. 1989).

When we view the evidence in this case, we are convinced that the mark SCRATCHRESIST would immediately inform prospective purchasers of a feature or characteristic of applicant's hardwood flooring. Therefore, the term is merely descriptive.

Decision: The refusal to register is affirmed.